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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/785,471	02/24/2004	Takuji Kato	14225-038001 / F1040007US	8555
26211	7590	03/23/2005	EXAMINER	
FISH & RICHARDSON P.C. CITIGROUP CENTER 52ND FLOOR 153 EAST 53RD STREET NEW YORK, NY 10022-4611			CLARK, SHEILA V	
			ART UNIT	PAPER NUMBER
			2815	

DATE MAILED: 03/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/785,471

Applicant(s)

KATO ET AL.



Examiner

S. V. Clark

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 8 and 9 is/are rejected.
- 7) ☒ Claim(s) 6, 7, 10 and 11 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Use of the word "stored" needs to be clarified. Is the element stored in a cavity of the resin or are the test values "stored"? To what does "stored" refer?

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-5, 8 are rejected under 35 U.S.C. 102(a) as being anticipated by Utsumi.

Utsumi shows in figures 3 and 4 a circuit device in which a circuit element is sealed by a sealing resin wherein figures 3 and 4 show a cavity portion (shown as a cut out in figures 3 and 4) is provide in sealing resin 1 and the circuit element 10 or 11 is stored in the cavity portion. The circuit element comprises a first element 10 sealed by the resin and a second element 11 stored in the cavity window portion (see col. 6, lines 32-33). Said elements are taught to be electrically connected. Connection terminal 2 is shown and the first element is a semiconductor control element (i.e. signal processing) and the second element is a memory element.

A circuit device comprising an island 13 (i.e. circuit board) on which circuit element 10 is shown. Figure 4 shows external terminals from said circuit element

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connected to circuit patterns (not labeled) but described in col.5, line 64 (" printed circuit patterns"). Sealing resin and second circuit element have been discussed supra.

Claim 9 is rejected under 35 U.S.C. 102(a) as being anticipated by Utsumi.

The method steps sealing and storing are inherently provided as described above in Utsumi.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Tanaka et al

Tanaka shows sealing resin 118 with cavity (see figure 4) having circuit element 124 formed therein and is electrically connected to terminals 104 provided on the peripheral portion of said cavity.

The method steps sealing and storing are inherently provided as described above in Tanaka et al.

Claims 1-5, 8, 9 are rejected

Claims 6, 7, 10, 11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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Shibata, Glenn et al, Huang, Glenn, Tsai and Karpman all show chips formed in resins.

Any inquiry concerning this communication should be directed to S. V. Clark at telephone number (571) 272-1725.

A handwritten signature in black ink, appearing to read 'S. V. Clark', with a long, sweeping horizontal line extending to the right.

S. V. Clark
Primary Examiner
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March 19, 2005